

**REMARKS**

Applicants concurrently file herewith an Excess Claim Fee Payment Letter, and excess claim fee, for four (4) excess claims and one (1) excess independent claim.

Claims 1, 3-15 and 18-27 are all of the claims presently pending in the application. Claims 1, 3-7 and 12 have amended to more clearly describe the claimed invention. Claims 21-27 have been added to provide more varied protection for the claimed invention and to claim additional features of the invention.

It is noted that the claims amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims, or for any statutory requirements of patentability. Further Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1, 2, 6 and 7-9 stand rejected under 35 U.S.C. §102(e) as being anticipated by Yoshino et al. (U.S. Patent No. 6,677,093; hereinafter "Yoshino"). Claims 1-12, 14 and 16-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi et al. (U. S. Patent No. 6,130,017; hereinafter "Hayashi") in view of JP 2002-129063 (hereinafter "JP '063") and JP 2000-319021 (hereinafter "JP '021"). Claims 13 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '063 in view of Yaguchi.

These rejections are respectfully traversed below.

**I. THE CLAIMED INVENTION**

The claimed invention (e.g., as defined by exemplary claim 1) is directed to an

electrophotographic toner. The toner includes a fixing resin and a colorant. The electrophotographic toner includes a black toner using titanium oxide having no carbon black as the colorant (e.g., see Application at page 3, lines 2-21). This combination of features is important for providing a toner paying more attention to environment and safety while also being fixed at a low temperature with increased speed and reduced fixing energy (see Application at page 2, lines 9-25).

## II. THE PRIOR ART REFERENCES

### A. The Rejection of Claims 1, 2, 6 and 7-9

The Examiner alleges that Yoshino teaches the claimed invention of claims 1, 2, 6 and 7-9. Applicants submit, however, that Yoshino does not teach or suggest each and every feature of the claimed invention.

That is, Yoshino does not teach or suggest that “*said electrophotographic toner comprises a black toner using a titanium oxide comprising no carbon black as said colorant*”, as recited in claim 1 (and similarly recited in claim 12).

The examiner attempts to rely on column 1, lines 35-45, column 9, lines 5-20 and column 13, lines 1-10 of Yoshino to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in these passages (nor anywhere else for that matter) does Yoshino teach or suggest an electrophotographic toner including a black toner using a titanium oxide having no carbon black as the colorant. Indeed, the Examiner does not even address this feature in his rejection.

The Examiner merely alleges that Yoshino teaches an electrophotographic one or two-

component black toner including a black pigment having a hematite structure. Nowhere, however, does the Examiner allege that Yoshino teaches an electrophotographic toner including a black toner using a titanium oxide having no carbon black as the colorant.

Furthermore, Yoshino specifically teaches that the electrophotographic toner may include carbon black as an external additive (see Yoshino at column 13, lines 9-10).

Furthermore, the Examiner concedes that Yoshino does not teach or suggest this feature. In the previous Office Action, the Examiner stated that “the use of titanium oxide as a colorant is not taught” (see Office Action dated October 7, 2005 at page 2). Furthermore, the Examiner, currently, merely alleges that Yoshino teaches a metal oxide as a black toner.

The Examiner alleges that the metal oxide of Yoshino “may further contain additional metal atoms such as Ti” and that the “electrophotographic toner may contain external additives outside the toner particles”. However, nowhere does Yoshino teach or suggest that the metal atoms of Ti include titanium oxide.

Moreover, Yoshino does not teach or suggest that “*the titanium oxide exhibits oil absorption of not higher than 80 ml/100 g*”, as recited in claim 1.

Indeed, the Examiner does not even address this feature in his rejection.

Therefore, Applicants submit that Yoshino does not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

#### **B. The Rejection of Claims 1-12, 14 and 16-20**

The Examiner alleges that Hayashi would have been combined with JP ‘063 and JP ‘021 to teach the claimed invention of claims 1-12, 14 and 16-20. Applicants submit,

however, that the Examiner has clearly failed to establish a *prima facie* case of obviousness. Therefore, Applicants are not required to amend the claims or provide rebuttal arguments to overcome the Examiner's rejection.

That is, the M.P.E.P. clearly sets forth (as should be well aware to the Examiner) that in order "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations" (emphasis added) (see M.P.E.P. § 2142). Applicants point out that in order to establish a *prima facie* case of obviousness, all three of the above requirements must be met.

Furthermore, the M.P.E.P. sets forth that "[t]he initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done" (see M.P.E.P. 2142). If the Examiner does not produce a *prima facie* case, then Applicants are under no obligation to submit evidence of nonobviousness.

In the rejection of claims 1-12, 14 and 16-20 the Examiner alleges that JP '063 teaches a metal oxide black toner having no carbon black. Furthermore, the Examiner alleges that JP '063 teaches measurement of oil absorption. The Examiner then alleges that "[i]t would have been obvious to one of ordinary skill in the art at the time of applicants' invention with a reasonable expectation of success to use the black metal oxides as the black toner in a toner composition utilized in a known image forming method utilizing electrophotographic developers" (see Office Action dated May 31, 2006 at pages 2-3).

Applicants submit that the Examiner has clearly failed to establish a *prima facie* case of obviousness because the Examiner's rejection does not include a suggestion or motivation to combine the reference teachings. Indeed, the Examiner merely alleges that it would have been obvious to combine the references. However, the Examiner has not provided any suggestion or motivation to make the alleged combination.

Therefore, Applicants submit that the Examiner has clearly failed to establish a *prima facie* case of obviousness. Therefore, since the Examiner's rejection is procedurally lacking all of the requirements for establishing a *prima facie* case of obviousness, in accordance with the M.P.E.P., Applicants are not required to present rebuttal arguments because the Examiner has failed to meet his initial burden.

Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

### **C. The Rejection of Claims 13 and 15**

The Examiner alleges that JP '063 would have been combined with Yaguchi to teach the claimed invention of claims 13 and 15. Applicants submit, however, that the Examiner has clearly failed to establish a *prima facie* case of obviousness. Therefore, Applicants are not required to amend the claims or provide rebuttal arguments to overcome the Examiner's rejection.

That is, the M.P.E.P. clearly sets forth (as should be well aware to the Examiner) that in order "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference

or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations” (emphasis added) (see M.P.E.P. § 2142). Applicants point out that in order to establish a *prima facie* case of obviousness, all three of the above requirements must be met.

Furthermore, the M.P.E.P. sets forth that “[t]he initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done” (see M.P.E.P. 2142). If the Examiner does not produce a *prima facie* case, then Applicants are under no obligation to submit evidence of nonobviousness.

In the rejection of claims 13 and 15 the Examiner alleges that JP ‘063 teaches a toner and carrier used in a magnetic developing system. Furthermore, the Examiner alleges that Yaguchi teaches a forward and backward magnetic roll in a center feed type developing unit. The Examiner then alleges that “[i]t would have been obvious to one of ordinary skill in the art at the time of applicants’ invention with a reasonable expectation of success to center feed units as the magnetic rolls with a black metal oxide toner in the development of image” (see Office Action dated May 31, 2006 at page 3).

Applicants submit that the Examiner has clearly failed to establish a *prima facie* case of obviousness because the Examiner’s rejection does not include a suggestion or motivation to combine the reference teachings. Furthermore, the Examiner has failed to address each and every feature of the claimed invention in his rejection. Indeed, the Examiner merely alleges that it would have been obvious to combine the references. However, the Examiner has not provided any suggestion or motivation to make the alleged combination.

Furthermore, Applicants point out that claims 13 and 15 are dependent claims, which

depend from independent claims 12 and 14, respectively. Thus, claims 13 and 15 include all of the limitations cited in claims 12 and 14, respectively. The Examiner, however, has failed to address any of the features recited in claims 12 and 14 (let alone show that the prior art references teach or suggest each of these features). The Examiner merely alleges that JP '063 teaches a toner and a carrier used in a magnetic developing system. The Examiner has not addressed any of the claimed features of the toner nor the image-forming system.

Therefore, Applicants submit that the Examiner has clearly failed to establish a *prima facie* case of obviousness. Therefore, since the Examiner's rejection is procedurally lacking all of the requirements for establishing a *prima facie* case of obviousness, in accordance with the M.P.E.P., Applicants are not required to present rebuttal arguments because the Examiner has failed to meet his initial burden.

To meet his initial burden, Applicants point out that the Examiner must provide a motivation or suggestion to combine the references and the Examiner must address each and every feature of the claimed invention.

Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

### **III. NEW CLAIMS**

New claims 21-27 are added to provide more varied protection for the claimed invention and to claim additional features of the invention. These claims are independently patentable because of the novel features recited therein.

Applicants submit that new claims 21-27 are patentable over any combination of the applied references at least for analogous reasons to those set forth above with respect to

claims 1, 3-15 and 18-20.

#### IV. CONCLUSION

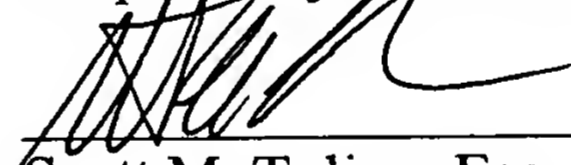
In view of the foregoing, Applicants submit that claims 1, 3-15 and 18-27, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

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Respectfully Submitted,



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